

STATEMENT OF COMMON OWNERSHIP

Application Serial No. 10/770,457 and U.S. Patent Nos. 6,627,015 and 6,000,784, were, at the time the invention of Application Serial No. 10/770,457 was made, owned by Ricoh Company, Ltd.

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1 and 2 are currently pending. Claim 1 has been amended; and Claim 2 has been added by the present amendment. The changes and additions to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter; the Office indicated that priority under 35 U.S.C. § 120 has not been granted due to the Office Action's position that the claims do not satisfy 35 U.S.C. § 112, first paragraph; the Office Action indicates that a new Declaration is required; Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,100,784 to Takemoto et al. (hereinafter "the '784 patent") in view of Japanese Application Publication No. JP 58049636 (hereinafter "the '636 patent"); Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,627,015 to Takemoto et al. (hereinafter "the '015 patent") in view of the '636 patent; and Claim 1 was rejected on the grounds of non-statutory obvious-type double patenting as being unpatentable over Claim 6 of the '015 patent in view of the '636 patent.

Amended claim 1 is directed to a method of adhering a first member to a second member via an intermediate member, the method comprising: (1) positioning the first member and the second member relative to each other; (2) applying a first adhesive to a first surface destined to comprise a first interface between the first member and the second member; (3) applying a second adhesive to a second surface destined to comprise a second interface between the second member and the intermediate member; (4) contacting the first member to the intermediate member via the first adhesive to form the first interface; (5) contacting the second member to the intermediate member via the second adhesive to form

the second interface; and (6) curing the first adhesive and the second adhesive using UV light, wherein, during the curing step, the intermediate member moves due to contraction of at least one of the first adhesive and the second adhesive due to curing, wherein the curing step includes filtering the light such that a color of the intermediate member is maintained.

Further, Claim 1 recites that after curing, the first member and the second member are fixed to the intermediate member and therefore fixed to each other. The changes to Claim 1 are supported by the originally filed specification and do not add new matter.¹

Applicants wish to thank the Examiner for the telephone interview granted Applicants' representative on October 24, 2007. The Examiner indicated that if the claims were amended to recite "moves" instead of "can move," the objection to the specification would be over come.

Applicants respectfully submit that the objections to the specification, Applicants claim to priority, and Applicants' declaration are rendered moot by the present amendment to Claim 1. Applicants note that the Office Action on page 9 admits that the specification provides support for the "moves" limitation recited in the claims.

Thus, Applicants submit that the present claims are entitled to domestic priority to January 27, 1999, which is the filing date of the grandparent Application No. 09/237,661, from which the present application depends. Moreover, since the '015 and '784 patents both has an effective filing date of March 10, 1998, and were patented and/or published after January 27, 1999, the '015 and '784 patents qualify as prior art only under 35 U.S.C. § 102(e).

Regarding the rejection of Claim 1 under 35 U.S.C. § 103 as being unpatentable over the '784 and '636 patents, the present application and U.S. Patent No. 6,000,784 were, at the time the invention of the present application was made, owned by Ricoh Company, Ltd. See Statement of Common Ownership. Moreover, as set forth above, the '784 patent qualifies as

¹ See, page 51, lines 2-13 which correspond to paragraph [0157] in the published application. Emphasis added.

prior art only under 35 U.S.C. § 102(e). Accordingly, under 35 U.S.C. § 103(c), the '784 patent cannot be used in a rejection under 35 U.S.C. § 103 against the claims in the present application. See MPEP § 706.02(1)(2). Accordingly, Applicants request that the rejection of the claims as being unpatentable over the '784 and '636 patents be withdrawn.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103 as being unpatentable over the '015 and '636 patents, the present application and U.S. Patent No. 6,627,015 were, at the time the invention of the present application was made, owned by Ricoh Company, Ltd. See Statement of Common Ownership. Moreover, as set forth above, the '015 patent qualifies as prior art only under 35 U.S.C. § 102(e). Accordingly, under 35 U.S.C. § 103(c), the '015 patent cannot be used in a rejection under 35 U.S.C. § 103 against the claims in the present application. See MPEP § 706.02(1)(2). Accordingly, Applicants request that the rejection of the claims as being unpatentable over the '015 and '636 patents be withdrawn.

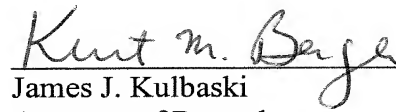
Applicants respectfully submit that the double patenting rejection of Claim 1 is rendered moot by the terminal disclaimer filed herewith.

The present amendment also sets forth new Claim 2 for examination on the merits. Claim 2 recites limitations analogous to the limitations recited in Claim 1, but states that the curing step includes filtering said light such that said intermediate member does not deform due to the UV light. Claim 2 is supported by the originally filed specification and does not add new matter.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Kurt M. Berger", is written over a horizontal line.

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